



Docket No.: 1293.1315

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Kun-soo KIM et al.

Confirmation No. 2397

Serial No. 10/073,061

Group Art Unit: 2627

Filed: February 12, 2002

Examiner: Aristotelis M. PSITOS

For: TRACKING ERROR SIGNAL DETECTING METHOD SELECTIVELY USING A PUSH-PULL METHOD, AN IMPROVED PUSH-PULL METHOD, AND A THREE BEAM METHOD AND OPTICAL RECORDING/REPRODUCING APPARATUS USING THE SAME (AS AMENDED)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection in the above-identified application.

No amendments are being filed with this request.

The request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 4-13-07

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Reasons for Request for Review

Status of Claims

Claims 1, 2, 4, 6-34, 50-55, and 60-74 are pending and stand finally rejected. Claims 1, 68, and 72 are the independent claims. All of the independent claims stand rejected under: 35 U.S.C. § 103(a) as being unpatentable over JP 10-149564 (JP '564) in view of JP 07-320287 (JP '287); 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,597,642 (Ijima) in view of JP '287; and 35 U.S.C. § 102(e) as being anticipated by Ijima. Also, the claims are objected to because claims 72-74 are allegedly substantial duplicates of claims 1, 2, and 67.

Reason Number 1

The objection to claims 72-74 as substantial duplicates of claims 1, 2, and 67 should be withdrawn because there are differences between these respective claims.

In an Attachment to the Request for Reconsideration Under 37 CFR 1.116 filed February 13, 2007 ("Request for Reconsideration Under 37 CFR 1.116"), these differences were demonstrated by a side to side comparison of independent claim 1 and independent claim 72.

Reason Number 2

The rejection of claims 1, 2, 14-21, 29-34, and 66-74 under 35 U.S.C. § 102(e) as being anticipated by Ijima should be withdrawn because of the Office's own admission that there are differences between the claimed invention and Ijima.

For example, in the 5th-8th paragraphs of the "Response to Arguments" section of an Advisory Action mailed March 12, 2007 ("Advisory Action"), the Office acknowledges at least one express difference between the claims and Ijima.

Also, independent claims 1, 68, and 72 recite the following "switch" features: that a light detecting device includes a switch selectively outputting first and second detection signals to the first and second detecting portions [of a signal processor], respectively (independent claim 1); and

a light detection device ...[that] includes a switch selectively outputting a first detection signal and a second detection signal [a signal processor] (independent claim 72).

Independent claim 68 corresponds generally to independent claim 1 and recites similar features in method form. (Request for Reconsideration Under 37 CFR 1.116, pages 2 and 11-13).

In contrast, Ijima teaches that selection circuit 302 (alleged in the Final Office Action mailed October 13, 2006 ("Final Office Action") to be a switch):

- receives signals that differ from those of the claimed switches;
- outputs signals that differ from those of the claimed switches;
- outputs signals to components that differ from that of the claimed switches; and
- is not located in a light detection device as are the claimed switches.

These differences are discussed in detail at pages 15 and 16 of the Request for Reconsideration under 37 CFR 1.116.

Thus, the rejection under 35 U.S.C. § 102 should be withdrawn.

Reason Number 3

The rejections of independent claims 1, 68, and 72 under 35 U.S.C. § 103(a) should be withdrawn because: (1) neither JP '287 nor Ijima disclose the "switch" features; (2) the asserted combination impermissibly changes principles of operation; (3) the differences between the asserted combinations and the claims are not merely matters of design choice; and (4) the rejections are deficient under MPEP § 2142 for lack of a convincing line of reasoning. Each basis is discussed in turn.

In both rejections under 35 U.S.C. § 103, the Office relies on either JP '287 or Ijima for the necessary suggestion of the aforementioned "switch" features. (Office Action, pages 5 and 9). However, the alleged switches of JP '287 and Ijima differ in several ways in function and location from those claimed such that they do not suggest the aforementioned "switch" features, as discussed at pages 15 and 16 of the Request for Reconsideration Under 37 CFR 1.116.

Also, the necessary motivation to make the asserted modifications/combinations cannot be said to be present because the asserted modifications change principles of operation, as discussed at page 18 of the Request for Reconsideration Under 37 CFR 1.116.

Further, the claimed switches cannot be said to be obvious matters of design choice since they provide advantages not recognized by the cited art. In particular, as explained at paragraph [0046] of Applicants' disclosure, the specific arrangement expressly recited by the aforementioned features provides an advantage not recognized by the cited art. Specifically, locating the switch as claimed minimizes the number of output terminals of a light detection device circuit. This advantage, it is submitted, is not recognized by any of the asserted citations and is evidence that the subject differences are not merely design choice.

Lastly, it is submitted that the Office must articulate a convincing line of reasoning for the asserted combinations but has not done so. It is well-settled law that the initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. This burden is satisfied when the references expressly or impliedly suggest the claimed invention or the examiner presents "a convincing line of reasoning" as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. **Thus, when the motivation to combine/modify the teachings of the references is not immediately apparent, it is the duty of the Office to provide a convincing line of reasoning explaining why the combination of the teachings is proper. (MPEP § 2142).**

The Office Action has not disputed differences in the functions and locations of the elements of JP '287 and Ijima et al. and the aforementioned "switch" features. Rather, the Office contends that the necessary modification of these disclosures would be for "financial" reasons. (Advisory Action, page 2). Thus, it is the Office's contention that one of ordinary skill in the art would have been financially motivated to make the suggested modifications of the change means 36 of JP '287 and a selection circuit 302 of Ijima.

It is respectfully submitted since neither JP '287 nor Ijima expressly or impliedly suggest the asserted modifications, a "convincing line of reasoning" is required by MPEP § 2142 for the reasons set forth at page 17 of the Request for Reconsideration Under 37

CFR 1.116). Thus, it is submitted that it is incumbent upon the Office to set forth a convincing line of reasoning as to why an ordinarily skilled artisan, without the benefit of Applicants' disclosure, would have modified the change means 36 of JP '287 or the selection circuit 302 of Ijima so that these components: (1) function in the same manner as the claimed switches; and (2) are located in the same location as the claimed switches.

The Office relies merely on a financial motivation. (Advisory Action, page 2). It is submitted that this specific motivation does not rise to the required convincing standard.

For any of these reasons alone, the rejections under 35 U.S.C. § 103 should be withdrawn.